

REMARKS

Reconsideration of this application, as presently amended, is respectfully requested.
Claims 19-36 are pending in this application. Claims 19-36 stand rejected.

Claim Rejections – 35 U.S.C. §1.112

Claims 19-34 are rejected under 35 U.S.C. §112, first and second paragraphs, as failing to comply with the written description requirement and as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The specific rationale for the rejection is set forth on page 3, lines 1-11 of the Office Action. The Examiner asserts

The claims (19 herein as example) recite retrieving and sending to the client a nearest “printing agent printer site” and then goes on to retrieve the most recently used “printing agent printer sites” and then receiving “printer agent printing site” and the printing at the selected “printer agent printing site”. ***Thus, the client receives both the nearest and predetermined number list or recently used in the same session. This is not taught in the specification and is deemed to be new matter.*** Further, it is unclear to what the user is selecting to be printed at, ***because the client specified the site already in the 4th limitation as well as the last,*** which does not make much sense to the Examiner as to what is being claimed and the support is lacking for this in the disclosure.

Claim 19 has been amended to clarify the invention in a manner that corresponds to and is consistent with Fig. 14 of the application. Specifically, as illustrated in Fig. 14, steps S32, S33 and S34, and the accompanying description, the specification teaches that either the nearest

printing agent printer sites are listed (No, step S32) or the most recently used printing agent printer sites are listed (Yes, step S33).

Further, claim 19 has been amended to clarify the claim language regarding printing out at the selected printing agent printer site. Specifically, prior to the present amendment, claim 19 recited both “receiving the printing agent printer site...” (fifth paragraph) and “receiving a selected printer agent printing site...” (seventh paragraph). However, the method described in the specification includes only one step of selecting a printer (see step S36 in Fig. 14), and does not encompass separate steps of receiving printing agent printer sites selected in two different steps. Claim 19 has been amended to clarify this feature in a manner consistent with the specification.

Claim 20 has also been amended to clarify the same issues discussed above for claim 19.

Finally, the Examiner also objects to the use of both “printer agent printing site” and “printing agent printer site” in the claims, and asserts that it is unclear “if these are two distinct [types] of things or if Applicant is referring to these [as the] same entity.” The “printer agent printing site” and “printing agent printer site” are intended to refer to the same entity or entities. Therefore, the claims have been amended to change “printer agent printing site” to --printing agent printer site-- throughout the claims.

In view of the above amendments and remarks, reconsideration and withdrawal of the rejections under §112, first and second paragraphs, are respectfully requested.

Claim Rejections – 35 U.S.C. §103

Claims 19, 20, 21, 23, 28, 30 35 and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka** (USP 6,522,971, previously cited) in view of **Fritsch** (USP 6,247,130, previously cited). Claims 22 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka** and **Fritsch** as applied to claims 19 and 20 above, and further in view of **Britt et al.** (USP 6,647,267, previously cited). Claims 31 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka** and **Fritsch** as applied to claims 19 and 20 above, and further in view of **Minari** (USP 6,809,831, previously cited). Claims 32 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka** and **Fritsch** as applied to claims 19 and 20 above, and further in view of **Kawai** (USP 6,404,994, previously cited). Claims 26 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka** and **Fritsch** as applied to claims 19 and 20 above, and further in view of **Satomi et al.** (US 2004/0039641, previously cited). Claims 27 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Tanaka** and **Fritsch** as applied to claims 19 and 20 above, and further in view of **Hanzawa** (USP 5,506,661, previously cited).

Independent claims 19, 20, 35 and 36 have all been rejected over the combination of **Tanaka** in view of **Fritsch**. The Examiner provides a detailed discussion of the rejection of independent claim 36 (see Office Action, Item 4, page 3 – page 5, line 8), and rejects claims 19, 20 and 35 for reasons similar to those presented for claim 36 (see Office Action, page 5, lines 9-14).

The **Tanaka** reference has been discussed in detail in previous responses. That discussion is hereby incorporated by reference.

The Examiner's current position is that **Tanaka** discloses all that is claimed except for the "history information including past used sites/services is sent to the client terminal." (see last two lines of page 4 of Office Action). The Examiner relies on **Fritsch** to teach the features missing from **Tanaka**.

Further, the Examiner responds to the patentability arguments regarding claims 19 and 20 set forth in the Submission under 37 C.F.R. §1.114 filed on February 28, 2006 by asserting:

Regarding the predetermined number, *since the number of items to be displayed is known before the user logs in for a session, the number is predetermined before the session*. Regarding a list of most recently used, *Fritsch displays the full list of what users have used/purchased in the past, thus displaying all (including the most recently used items)*. Regarding whether the items will be selected again, one reason Fritsch can display the items is for a user to be able to select them again if need be (e.g., to get product information again or the like). Thus, the idea of presenting a user with a predetermined list of services previously used is well known in the art and would have been obvious to combine as outlined below. See *Response to Arguments* in paragraph bridging pages 9 and 10 of Office Action. [emphasis added]

Claims 19 and 20

It is respectfully submitted that none of the cited references, whether taken alone or in combination, disclose, suggest or render obvious the method/apparatus, as presently recited in claims 19 and 20, wherein it is determined whether a user ID indicates that a user has used the printing agent service in the past, and, based on the determination regarding the user ID, (1) a predetermined number of most recently used printer sites are sent to the client terminal as

candidate printing agent printer sites for selection by the user in response to the user ID indicating that the user has used the service in the past, and (2) a nearest printer agent printing site is sent to the client terminal as a candidate for selection by a user when the user ID indicates the user has not used the service in the past.

The **Tanaka** reference discloses a service center that stores a database of history information of accesses by each user terminal. See e.g., col. 5, lines 16-25. The history of accesses is used to determine whether an initial guidance screen is displayed for a new user of a service (see col. 5, lines 26-28). When a user requests a service that the user terminal requested in the past, a continuative guidance screen is displayed (see col. 5, lines 31-33).

However, in contrast to the presently claimed invention, the user history (i.e., whether the user terminal has accessed the service in the past) in **Tanaka** is not related to determining which printing agent printer site candidates are presented to the user for selection. **Tanaka** apparently provides to a user candidate printing sites for printing in the same manner regardless of whether a user has used that site in the past or not.

The **Fritsch** reference teaches history software that stores in a database information for all previous sales activity for a particular PC user. In the particular embodiment disclosed by **Fritsch**, the history software lists all previous tracks/albums purchased by the PC user. As stated in **Fritsch** “The shopping history sub-system allows every customer who has ever previously shopped *on the web site* to access a list of all products that the consumer has purchased in the past” [emphasis added]. See col. 6, lines 62-65.

Thus, **Fritsch** does not alleviate the deficiencies of **Tanaka**. Specifically, **Fritsch** does not disclose or suggest a method/system that uses a user history (i.e., whether the user terminal has accessed the service in the past) to determine which printing site candidates are presented to the user for selection (i.e., whether most recently used sites or whether nearest site are presented for selection). Unlike the claimed invention, **Fritsch** simply teaches listing all user purchases from a particular Web site. Although this list of all user purchases is a type of user history, this history is not used to determine which candidate sites are presented to a user for selection of a printing site.

Further, it is submitted that if the **Tanaka** and **Fritsch** references were combined, the result would be a method/system that provides a list of service providers (e.g., stores) and the respective distances to those service providers (as shown in Figs. 11A and 11B of **Tanaka**), and that provides a list of purchase from a service provider *if* the user purchases something on-line from the service provider's Web site.

The combination of **Tanaka** and **Fritsch** would not result in a method/system wherein it is determined whether a user ID indicates that a user has used the printing agent service in the past, and, based on the determination regarding the user ID, (1) a predetermined number of most recently used printer sites are sent to the client terminal as candidate printing agent printer sites for selection by the user in response to the user ID indicating that the user has used the service in the past, and (2) a nearest printer agent printing site is sent to the client terminal as a candidate for selection by a user when the user ID indicates the user has not used the service in the past.

Furthermore, it is submitted that motivation for combining the references provided by the Office Action is not supported by the references, as is required under §103. Specifically, page 5, lines 4-5 of Office Action assert “*It would have been obvious that the history stored in Tanaka would be useful to the user so they could see and access sites they have used before.*”

However, neither **Tanaka** nor **Fritsch** disclose or suggest using a history as a factor in accessing sites they have used before. **Tanaka** teaches that the user history of accesses is used to determine whether an initial guidance screen or a continuative guidance screen is displayed. **Fritsch** teaches displaying a history of purchases from a **single** Web site, and does not use this history as a factor in seeing and accessing sites they have used before.

The Examiner also asserts “*The motivation for providing such history to the user would have been to allow the user to use the services they have used before without having to remember how to locate them on the network and allows faster access if the user is in a hurry.*”

However, the history in **Fritsch** does not “allow the user to use services [plural] they have used before” because **Fritsch** only stores a history of purchases for a **single** Web site.

Finally, it is noted that the Examiner concludes the **Response to Arguments** by stating “Thus, the *idea* of presenting a user with a predetermined list of services previously used is well known in the art and would have been obvious to combine as outlined below.” [emphasis added].

However, it is noted that it is improper to judge the obviousness of the “idea” behind the invention. It is well established that “Reducing a claimed invention to an ‘idea,’ and then determining patentability of that ‘idea’ is error. Analysis properly begins with the claims, for

they measure and define the invention.” *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984).

In view of the above amendments and remarks, it is respectfully submitted that claims 19 and 20, and claims dependent thereon, patentably distinguish over the cited prior art and define allowable subject matter. Reconsideration and withdrawal of the rejection of claims 19-34 are respectfully requested.

Claims 35 and 36

Claims 35 and 36 have been amended to incorporate features similar to those recited in claims 25 and 32. The **Kawai et al.** reference was applied against the claims to teach the features in claims 25 and 32. However, **Kawai et al.** do not disclose or suggest the features currently recited in claims 35 and 36. More particularly, **Kawai et al.** teach a copier capable of receiving a debit card. The Examiner considers the control unit for the debit card to be a server. However, unlike the presently claimed invention, the control unit does not receive printing results from any printer at the printer agent printing sites. Further, unlike **Kawai et al.** the invention presently recited in claims 35 and 36 allows charging of a user in a remote place.

Accordingly, it is respectfully submitted that each of claims 35 and 36 patentably distinguish over the cited prior art for the reasons set forth above.

Application No. 09/822,228
Art Unit: 2625

Amendment under 37 C.F.R. §1.111
Attorney Docket No.: 010273

CONCLUSION

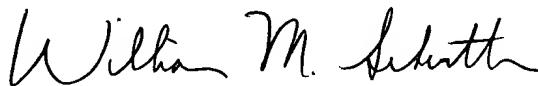
In view of the foregoing amendments and accompanying remarks, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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